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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,619	06/18/2001	Robert Martin Wynalda JR.	1949-A-CIP	5116

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EXAMINER

SIMONE, CATHERINE A

ART UNIT PAPER NUMBER

1772

6

DATE MAILED: 08/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/883,619

Applicant(s)

WYNALDA ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 and 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 8-9, 13-15 and 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation “a page adapted to hold ” in **claims 1, 2, 19 and 20** is deemed vague and indefinite. Maybe use another word besides “adapted” like “arranged”. Clarification is requested.

The recitation “substantially rigid” in **claims 1, 19 and 20** is deemed vague and indefinite. Clarification is requested.

The recitations “locking fingers” in **claims 8 and 9**, “planar portions” in **claims 13 and 14** and “living hinge” in claim **18** are deemed vague and indefinite. Clarification is requested.

The recitation “the edge of the page connected to the cover is V-shaped in cross-section to provide a pocket for the adhesive” in **claim 7** is deemed vague and indefinite, Clarification is requested.

The recitation “locking finger is disposed in a pocket to protect the locking finger” in **claim 9** is deemed vague and indefinite. What do you mean? Clarification is requested.

*Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. **Claims 1-4 and 12-18** are rejected under 35 U.S.C. 102(b) as being anticipated by Weisburn et al. (5,697,498).

Weisburn et al. discloses a storage container for holding items of recorded media; the storage container comprising a cover (Fig. 2, #1) having a front cover member (Fig. 2, #6), a rear cover member (Fig. 2, #4), and a spine (Fig. 2, #40) disposed between the front and rear cover members; a page (Fig. 2, #60) adapted to hold at least one item of recorded media; the page appearing to have at least one edge; the edge of the page being connected to the spine to connect the page to the cover (Fig. 2, #90)); and the front and rear cover members appearing to be moveable between open and closed positions. Regarding **claim 2**, each page is adapted to hold two items of recorded media (see col. 3, lines 1-3). Regarding **claim 3**, each page includes two page halves connected together (Fig. 2). Regarding **claim 4**, each page appears to be substantially rigid (Fig. 2, #60). Regarding **claims 12**, note a literature card disposed between the page halves (see col. 3, lines 1-3). Regarding **claim 15**, at least one page halves appears to be substantially transparent (see col. 5, line 4). Regarding **claim 16**, note a second page adapted to hold at least one item of recorded media; the second page having at least one edge; the edge of the second page (Fig. 2, #63) connected to the cover. Regarding **claims 17 and 18**, the cover

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defines a hinge between the front cover member and the spine and a hinge between the rear cover member and the spine (see col. 4, lines 53-61).

It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Weisburn et al. (5,697,498) in view of House (5,791,468).

Weisburn et al. discloses a storage container for holding items of recorded media; the storage container comprising a cover (Fig. 2, #1) having a front cover member (Fig. 2, #6), a rear cover member (Fig. 2, #4), and a spine (Fig. 2, #40) disposed between the front and rear cover members; a page (Fig. 2, #60) adapted to hold at least one item of recorded media; the page appearing to have at least one edge; the edge of the page being connected to the spine to connect the page to the cover (Fig. 2, #90)); and the front and rear cover members appearing to be moveable between open and closed positions. However, Weisburn et al. fails to disclose the cover being made of paperboard. House teaches a cover being made of paperboard (see col. 6, lines 7-9) in the art for the purpose of producing a storage container for holding items of recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the cover in Weisburn et al. being made from paperboard as suggested in House in order to produce a storage container for holding items of recorded media.

7. **Claims 6, 7, 10, and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisburn et al. (5,697,498) in view of Udwin et al. (6,106,015).

Weisburn et al. discloses a storage container for holding items of recorded media; the storage container comprising a cover (Fig. 2, #1) having a front cover member (Fig. 2, #6), a rear cover member (Fig. 2, #4), and a spine (Fig. 2, #40) disposed between the front and rear cover members; a page (Fig. 2, #60) adapted to hold at least one item of recorded media; the page appearing to have at least one edge; the edge of the page being connected to the spine to connect the page to the cover (Fig. 2, #90)); and the front and rear cover members appearing to be moveable between open and closed positions. However, Weisburn et al. fails to disclose an adhesive and a weld to connect each page to the cover. Udwin et al. teaches an adhesive and a weld (see col. 6, lines 5-12) in the art for the purpose of providing secure attachment of each page to the cover in producing a storage container.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided an adhesive and a weld to a page in Weisburn et al. as suggested by Udwin et al. in order to provide a secure attachment of each page to the cover for producing a storage container.

8. **Claims 8 and 9** are rejected under 35 U.S.C. 103(a) as being unpatentable over Weisburn et al. (5,697,498) in view of Youngs (4,850,731).

Weisburn et al. discloses a storage container for holding items of recorded media; the storage container comprising a cover (Fig. 2, #1) having a front cover member (Fig. 2, #6), a rear cover member (Fig. 2, #4), and a spine (Fig. 2, #40) disposed between the front and rear cover members; a page (Fig. 2, #60) adapted to hold at least one item of recorded media; the page appearing to have at least one edge; the edge of the page being connected to the spine to connect the page to the cover (Fig. 2, #90)); and the front and rear cover members appearing to be moveable between open and closed positions. However, Weisburn et al. fails to disclose locking fingers. Youngs teaches locking fingers (Fig. 4, #70) in the art for the purpose of connecting the page halves together in a storage container for holding recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided locking fingers in Weisburn et al. as suggested by Youngs in order to connect the page halves together in a storage container for holding recorded media.

9. **Claim 19** is rejected under 35 U.S.C. 103(a) as being unpatentable over Roze (4,823,950) in view of House (5,791,468).

Roze discloses a storage container for holding items of recorded media; the storage container comprising a cover (Fig. 2, #50) having a front cover member (Fig. 2, #40), a rear cover member (Fig. 2, #20), and a spine (Fig. 2, #60) disposed between the front and rear cover members; the cover members defining a hinge between the front cover member and the spine (see col. 4, lines 33-37); each hinge being a living hinge; a page adapted to hold two items of recorded media on opposite sides of the page (see col. 3, lines 10-17); the page having at least one edge; the edge of the page being connected to the spine with an adhesive to connect the page

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to the cover (see col. 3, lines 55-61 and col. 4, lines 1-7); each page being substantially rigid (see col. 4, line 27); and the front and rear cover members being moveable between open and closed positions (see col. 1, lines 52-56). However, Roze fails to disclose the cover being made of paperboard. House teaches a cover being made of paperboard (see col. 6, lines 7-9) in the art for the purpose of producing a storage container for holding items of recorded media.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the cover in Roze being made from paperboard as suggested in House in order to produce a storage container for holding items of recorded media.

10. **Claim 20** is rejected under 35 U.S.C. 103(a) as being unpatentable over Weisburn et al. (5,697,498) in view of Roze (4,823,950).

Weisburn et al. discloses a storage container for holding items of recorded media; the storage container comprising a cover having a front cover member (Fig. 2, #6), a rear cover member (Fig. 2, #4), and a spine (Fig. 2, #40) disposed between the front and rear cover members; a page (Fig. 2, #60) adapted to hold two items of recorded media on opposite sides of the page; the page having at least one edge; each page being substantially rigid and including two halves (Fig. 6, #52-57); a literature card being disposed between the halves (see col. 3, lines 1-3 and col. 8, lines 55-58); and the front and rear cover members being moveable between open and closed positions. However, Weisburn et al. fails to disclose an adhesive on the edge of the paper. Roze teaches an adhesive on the edge of the page (see col. 4, lines 1-7) in the art for the purpose of attaching the page to the spine to connect to the cover.



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Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the edge of the page in Weisburn et al. with an adhesive as suggested in Roze in order to attach the page to the spine to connect to the cover.


*Conclusion*

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents are cited for further teachings of storage containers similar to that instantly disclosed.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703) 605-4297. The examiner can normally be reached on 9:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

  
Catherine Simone  
Examiner  
Art Unit 1772

August 12, 2002

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

8/12/02